

REMARKS

Prior to entry of this Response, Claims 20-29 were pending in this application. By the Response, the specification has been replaced, Claims 30-39 have been added, and FIGs. 9 and 10 have been corrected.

The Examiner is respectfully requested to consider the application in view of the amendments and associated remarks set forth herein.

I. SUMMARY OF THE AMENDMENTS

The amendments to the application are fully supported in the original Specification. No new subject matter has been added.

Amendments to the Specification

A substitute specification has been submitted with paragraph numbers added to the original text to facilitate their identification in the future prosecution of the application, and to bring the specification in compliance with 37 C.F.R. § 1.52(b)(5).

In addition, paragraph [0006] is amended to correct a typographical error, and paragraph [0026] has been amended to better describe the arrangement of articles shown in FIGs. 9-12.

Drawing Corrections

FIGs. 9 and 10 have been corrected to include brackets that more particularly identify the columns and rows of articles shown in the original drawings.

Amendments to the Claims

Claims 1-19 were previously canceled in the Preliminary Amendment.

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Claims 20-29 were added in the aforementioned Preliminary Amendment.

Claims 20, 21, 23 have been amended to clarify the limitations of the claimed invention.

Claims 30-39 are hereby added.

II. DRAWING REJECTIONS

The drawings were objected to under 37 C.F.R. § 1.83(a). FIGs. 9 and 10 have been corrected to more distinctly point out every feature of the invention that is shown in the drawings and specified in the claims.

III. CLAIM REJECTIONS

Under 35 U.S.C. § 112, first paragraph

Claims 20-29 have been rejected under the first paragraph of Section 112. According to the Office Action, the recitation in the rejected claims:

...relative to columns and rows is indefinite, as the specification defines the rows as 'vertically' arranged and the columns therefore horizontally arranged. However, applicants only show two columns as defined in any of the drawings. Therefore it is indefinite how the 'column that is adjacent to an endmost column' is any other but the other column. There is also no support for an 'uppermost row' or a 'lowermost row' or rows therebetween.

Office Action at ¶ 3. We disagree, and respectfully traverse this rejection.

In accordance with 35 U.S.C. § 112, the specification describes the subject matter of Claims 20-29 in full, clear, concise, and exact terms as to enable any person skilled in the art to make and use the same. With specific reference to the recitation of "columns and rows", paragraph [0026] of the Specification as originally submitted describes "the cartons illustrated in the drawings are adapted to hold a group of similarly dimensioned, cylindrical articles...in a

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plurality of vertically arranged rows (two rows in Figs. 10-12)." The original Specification is replete with descriptions of articles arranged in the same fashion. Specifically, with respect to cartons in general, the Specification states "there are typically multiple rows or tiers of articles, one above the other, carried within the carton." at ¶ [0004] (underlining added). Furthermore, the various embodiments of Applicant's invention improve on prior art cartons that carry articles in this fashion, by providing first and second detachable portions that define and redefine "an opening for dispensing articles from an upper or lower row of articles within the carton. See, e.g., ¶¶ [0006-7] (underlining added). In fact, the Specification as filed refers to the "upper" or "lower" row of articles approximately 25 times. See also ¶¶ [0032], [0035-6], and [0038-39]. Undoubtedly therefore, the Office Action misinterprets Applicant's description by asserting "the specification defines the rows as 'vertically arranged' and the columns therefore horizontally arranged," and that "applicants only show two columns as defined in any of the drawings." Office Action at ¶ 3. Rather, FIGs. 9-12 provide descriptive support for articles arranged in two rows, the articles in each row being disposed horizontally with respect to one another, with an upper row being disposed vertically with respect to a lower row. The Office Action also errs in finding "no support for an 'uppermost row' or a 'lowermost row' or rows therebetween," as it follows that two or more rows arranged in this fashion inherently must comprise an uppermost and a lowermost row. See MPEP § 2163.07(a).¹

These figures, and FIGs. 9 and 10 in particular, also provide clear support for the limitations of "columns and rows" in the claims. FIGs. 9 and 10 clearly demonstrate that pairs of

¹ MPEP § 2163.07(a) Inherent Function, Theory, or Advantage. By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter.

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adjacent articles in vertically adjacent rows are disposed vertically with respect to one another and thus, can inherently be referred to as columns. Id.

The Office Action is correct in indicating that the term "column" is not used in the Specification as originally filed. It is well established, however, that:

...the fact that an additional limitation to a claim may lack descriptive support in the disclosure as originally filed does not necessarily mean that the limitation is also not enabled. In other words, the statement of a new limitation in and of itself may enable one skilled in the art to make and use the claim containing that limitation even though that limitation may not be described in the original disclosure.

MPEP § 2164. To ensure certainty in construing the claims in the light of the specification, the specification has been amended at ¶ [0026], and FIGs. 9 and 10 have been corrected to more distinctly point out the relationship between the columns and rows of articles.² Thus, to the extent that Claims 20-29 were over indefinite, the rejections to these Claims have been overcome.

Under 35 U.S.C. § 112, second paragraph

Claims 20-29 were also rejected under the second paragraph of Section 112, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. According to the Office Action, "there is no antecedent to distinguish an 'endmost column', as no end has been defined." Office Action at ¶ 5. The rejection of these claims is respectfully traversed.

The second paragraph of § 112 requires the specification of a patent to "conclude with one or more claims particularly pointing out and distinctly claiming the

² While an applicant is not limited to the nomenclature used in the application as filed, he or she should make appropriate amendment of the specification whenever this nomenclature is departed from by amendment of the claims so as to have clear support or antecedent basis in the specification for the new terms appearing in the claims. MPEP § 608.01(o).

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subject matter which the applicant regards as his invention." 35 U.S.C. § 112, ¶ 2 (2000). To satisfy this requirement, the claim, read in light of the specification, must apprise those skilled in the art of the scope of the claim. See Miles Labs., Inc. v. Shandon, Inc., 997 F.2d 870, 875 (Fed. Cir. 1993). Moreover, claims need not "be plain on their face in order to avoid condemnation for indefiniteness; rather, what [this court has] asked is that the claims be amenable to construction, however difficult that task may be."

Smithkline Beecham Corp. v. Apotex Corp., Nos. 03-1285, -1313 (Fed. Cir. (N.D. Ill.) Apr. 8, 2005), citing Exxon Research & Eng'g Co. v. United States, 265 F.3d 1371, 1375 (Fed. Cir. 2001). As demonstrated above, the articles are arranged in rows and columns as defined in Applicant's Specification. The Specification describes an "endmost article" numerous times. See ¶¶ [0004], [0007], [0026], [0032], [0035], [0036], [0038], and [0039]. It follows, therefore, and those skilled in the art would readily recognize that the endmost article in each row comprises the endmost column.

Under 35 U.S.C. § 102

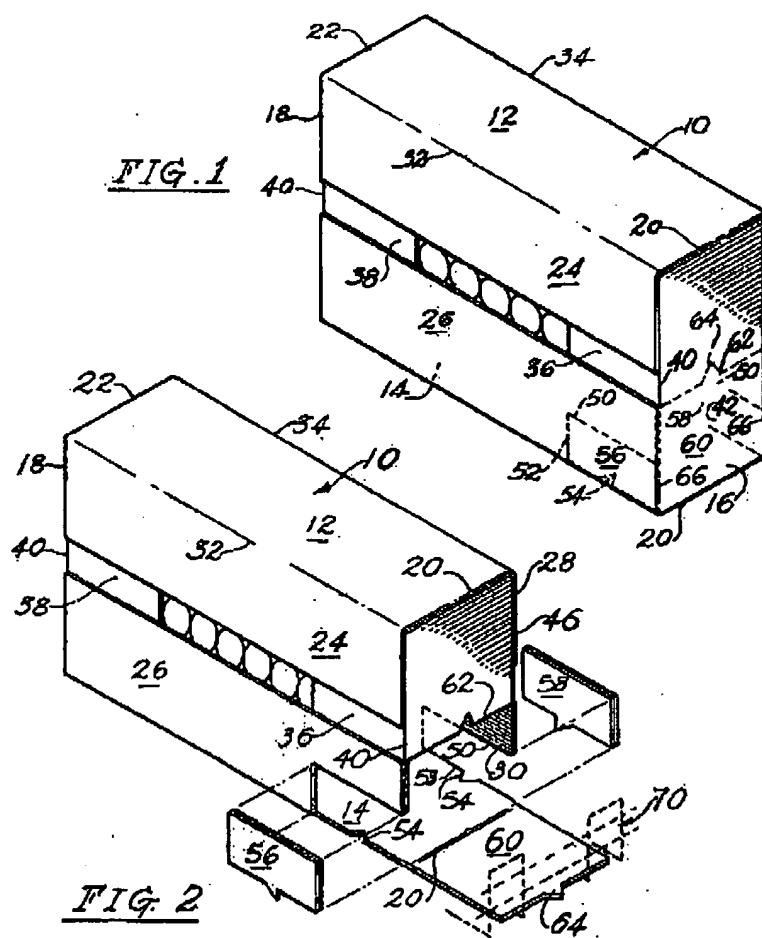
Claims 20-21 and 23-29 have been rejected under Section 102(b) as being anticipated by U.S. Patent No. 3,237,837 to Vizethann ("Vizethann"). Claims 20-22 and 24-29 have been rejected under Section 102(c) as being anticipated by U.S. Patent Appl. No. 2004/0089671 to Miller ("Miller"). Claims 20-21 and 23-29 have been rejected under Section 102(e) as being anticipated by U.S. Patent Appl. No. 2004/0232214 to Bates ("Bates").

None of the cited references discloses the limitations of amended Claim 20, or of its dependent Claims 21-29

Claim 20 has been amended to recite, *inter alia*, at least one detachable portion detachably formed from at least a first and a second adjacent wall, said at least one detachable portion to be detached from said carton to define an opening for exposing at least a portion of at least one article in a column that is adjacent to an endmost column of said article group.

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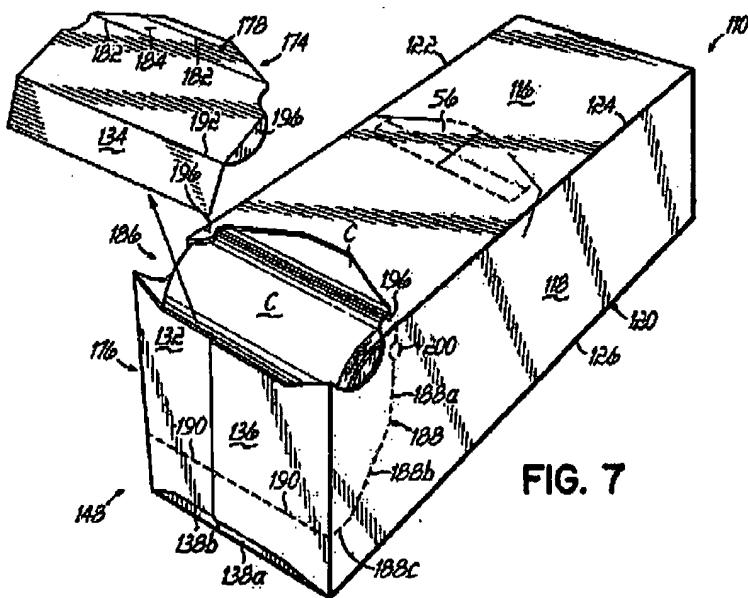
Vizethann fails to disclose the claimed invention, particularly because none of the portions 56, 58, and 60 disclosed therein are formed from at least a first and a second adjacent wall. Rather, portions 56 and 58 are formed from front flap 26 and rear flap 30, respectively. Col. 2, ll. 53-63. Portion 60 is formed from end 42, such "that the entire flap 60 may be bent about the fold line 20 on that end...." Col. 2, ll. 65 and 71-72. Clearly, each portion 56, 58, 60 is formed from a single flap or wall as can be seen in FIGs. 1 and 2, reproduced below.



Miller does not anticipate the claimed invention primarily because its dispenser does not expose at least a portion of at least one article in a column that is adjacent to an endmost

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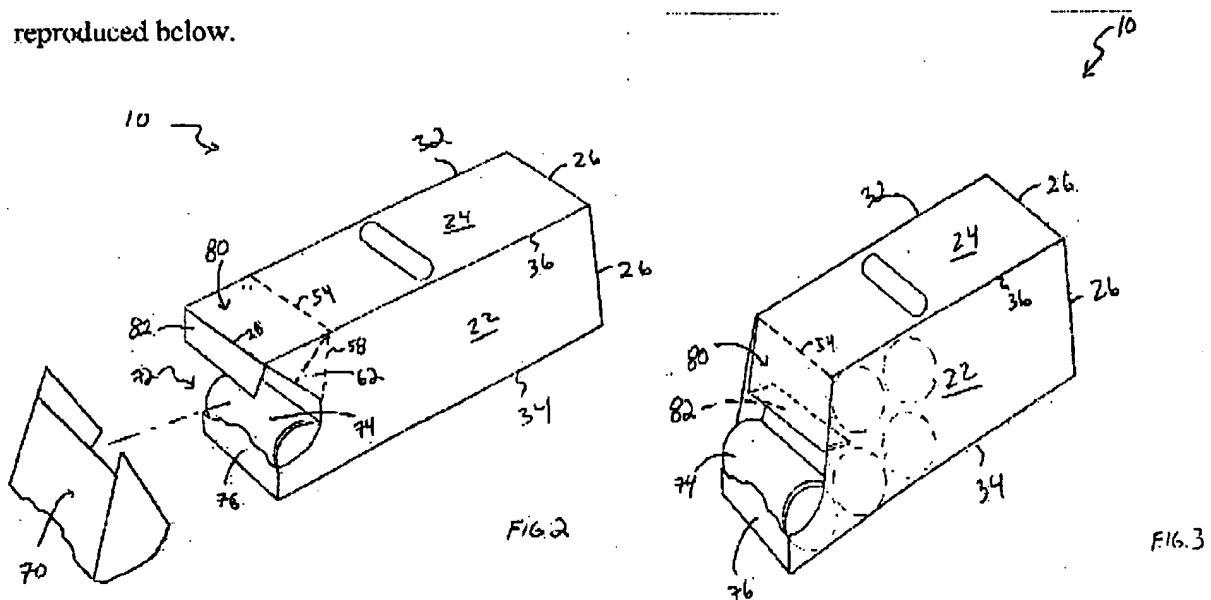
column of said article group. The Office Action refers to FIGs. 7-10 of *Miller* in support of the rejection; however, *Miller* teaches away from the limitations of amended Claim 20, disclosing instead "each tear line 188 extends across the adjacent end of the endmost can 'C' in the lower tier." See ¶ [0046] (underlining added). Moreover, FIG. 7 (reproduced below) shows that where tear line 188 extends across side wall 118, at most, the articles in the endmost column are exposed.



Similarly, the claimed invention is not disclosed by *Bates*, which includes no reference or teaching of at least one detachable portion to be detached from said carton to define an opening for exposing at least a portion of at least one article in a column that is adjacent to an endmost column of said article group. With particular reference to FIG. 2, the opening 72 as shown exposes only a portion of an end of an article in the endmost column. Furthermore, *Bates* includes no disclosure of the opening 72 exposing articles in the column that is adjacent to the endmost column. On the contrary, FIG. 3 clearly depicts the articles (drawn in dashed lines) in

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the column adjacent to the endmost column being completely unexposed. FIGS. 2 and 3 are reproduced below.



Because not one of the cited references discloses all of the limitations of amended Claim 20, the rejection of Claim 20 should be withdrawn. Claims 21-29 depend from Claim 20, and are also patentable over the cited references for this reason and on their own merit, as demonstrated below.

Vizethann fails to disclose the limitations of Claim 21

Claim 21 has been amended by deleting the word "fully", in order to conform with its parent claim and not for purposes of patentability. *Vizethann* does not disclose at least one partially detachable portion for restraining articles in said carton after said at least one detachable portion has been detached from the said carton. Although portion 60 may be considered partially detachable, it bends about fold line 20 "to form a flat surface on which cans will roll by gravity." Col. 3, ll. 1-2. Certainly, therefore, it can not be construed that portion 60 is for restraining articles.

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None of the cited references discloses the limitations of Claims 22-24

The Office Action erroneously contends that the cited references disclose the inventions of Claims 22-24. See ¶ 7. As demonstrated above, none of *Vizethann, Bates*, nor *Miller* discloses exposing at least a portion of said article in said column that is adjacent to said endmost column at all, and thus, does not disclose that article being in the uppermost row, lowermost row, or any row between the uppermost and lowermost rows, as recited in Claims 22, 23, and 24, respectively.

None of the cited references discloses the limitations of Claims 28 and 29

The Office Action asserts that "as to Claims 28 and 29, the openings of each could so act if the articles where actually located in the carton." Id. The undersigned attorney interprets this statement to suggest that if the carton contains articles in a column adjacent to an endmost column, the openings disclosed in each reference could expose at least a portion of an end of said at least one article in a column that is adjacent to an endmost column (Claim 28), or are sufficient to enable removal of said at least one article in a column that is adjacent to an endmost column (Claim 29).

With respect to Claim 28, it has been demonstrated above that none of the cited references disclose openings that expose articles in the column that is adjacent to the endmost column, so it follows that the references fail to disclose openings that expose the ends of those articles.

With respect to Claim 29, because the articles in the column that is adjacent to the endmost column are not exposed, it follows that the portion exposed is not sufficient to enable removal of those articles.

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Under 35 U.S.C. § 103(a)

Claim 22 has been rejected under Section 103(a) as being unpatentable over *Vizethann*. The Office Action states that to reverse the disposition of the carton such that side 12 is lowermost would fall within the level or ordinary skill in the art. *Id.* at ¶ 9. Applicant respectfully traverses this rejection and request reconsideration and withdrawal thereof.

To establish *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. See MPEP. § 2142.

It is well established that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). Here, reversing the disposition of the carton would render portion 60 unusable for its stated purpose, which is "to form a flat surface on which cans will roll by gravity." Col. 3, ll. 1-2.

Furthermore, the Office Action fails to establish existence of the third criterion of the *prima facie* case of obviousness. As demonstrated above, *Vizethann* fails to disclose all of the claim limitations of Claim 22, and clearly contains no teaching, suggestion, or motivation to modify in the manner suggested in the Office Action, particularly as the suggested modification renders portion 60 unusable.

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Vizethann neither discloses, teaches nor suggests the claimed invention, nor does it provide any motivation to modify the invention of *Vizethann* in the manner suggested. For at least these reasons, the rejection of Claim 22 is thus improper and should be withdrawn.

IV. NEW CLAIMS

Claims 30-39 have been added. Each of Claims 30-33 recites a detachable portion or an opening that exposes or extends to a space between the endmost column and the second endmost column, the space being defined by articles that are in adjacent rows. Further, Claims 34-39 recite a connecting severance line in a first wall of a carton, which interconnects upper and lower severance lines in a second carton wall, the connecting severance line defining an opening that extends along said first wall, said opening exposing or extending to a space between the endmost column and the second endmost column, the space being defined by articles in adjacent rows.

Vizethann does not disclose the invention of Claims 30-33 at least because only its carton only exposes articles in the lowermost row of articles, and thus, does not expose a space between articles in adjacent rows. *Vizethann* does not disclose the invention of Claims 34-39, at least because it also discloses no connecting severance line in the first wall (26) that interconnects upper and lower severance lines in the second wall.

Miller does not disclose the invention of Claims 30-39, at least because its opening does not extend to or expose a space between articles in adjacent rows, and it does not disclose a connecting severance line interconnecting upper and lower severance lines. For at least the same reasons, *Bates* fails to anticipate the recitation of Claims 30-39.

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For at least these reasons, the newly added claims are patentable over the cited references. Applicant requests timely allowance thereof.

V. CONCLUSION

No fee is believed to be due with respect to this Response. We respectfully request allowance of the claims pending in this case.

Should the Examiner believe that a telephone conference would be useful, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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